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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/062,258 | 01/31/2002 | Margnus Ljungstrom | HO-P02314US1 | 2268 |
| 26271 | 7590 | 05/03/2006 | [REDACTED] | EXAMINER |
| FULBRIGHT & JAWORSKI, LLP | | | | SNAY, JEFFREY R |
| 1301 MCKINNEY | | | [REDACTED] | ART UNIT |
| SUITE 5100 | | | | PAPER NUMBER |
| HOUSTON, TX 77010-3095 | | | | 1743 |

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CJ

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/062,258 | LJUNGSTROM ET AL. | |
| | Examiner | Art Unit | |
| | Jeffrey R. Snay | 1743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 February 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,4,7-13 and 21-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1, 3, 4, 7-13 and 21-28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02-17-2006 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4, 7-13 and 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon ('577).

Gordon discloses an optical analysis apparatus which clearly includes all of the presently recited elements. Referring to Figure 6, Gordon teaches the device including a rotatable disc holder (44), which is formed of plastic (column 5, line 1), a detector head (46), and a controller (49) for controlling positioning and operation of both the rotating disc and the detector head. The disc is rotated via a spindle motor (47) and the

detector head is moved step-wise via a stepper motor (48) (see column 8, last paragraph). The device of Gordon further includes an angular aligning system in the form of black bar (50) and a radial aligning system in the form of the disc edge (see column 9, first and second paragraphs). In operation, the black bar is sensed by the detector head to indicate a calibrated home angular position and the disc edge is sensed to indicate a calibrated home radial position. Subsequently, the controller and computer elements are capable of tracking relative movements of the detector head and disc such that precise determination of the position of the light source/detector arrangement relative to the disc is enabled (column 9, lines 21-24). In a similar but alternative embodiment, such positioning with respect to the surface of the disc, and consequently the samples located thereon, is provided by integrating digital encoding structures on the disc which are detected and interpreted by the detector (column 6, lines 20-32).

Regarding instant claim 3, Gordon discloses the use of laser light source (8) and acknowledges the application to measuring fluorescence (column 1, 3d paragraph). Regarding instant claim 4, see Gordon at column 8, 3d full paragraph). Regarding instant claims 5 and 6, it is noted that the relative coverage of the detection area would be entirely dependant on one's definition of the detection area. Thus, Gordon teaches coverage of at least one detection area defined as a single sample, and also teaches coverage of only a part of the detection area defined as the whole disc. Regarding instant claim 12, Gordon teaches the calibration mark (50) as being black. It is noted that instant claim 12 does not preclude the presence of other materials which are not

black. Regarding instant claim 13, Gordon teaches that detection agents are immobilized at different locations of the disc, including electrophoretic gels. Since the claim fails to define any particular flow conditions, and the substances in Gordon are immobilized throughout the operation of the device, it must be concluded that the limitation of instant claim 13 is fully satisfied by the Gordon device.

Response to Arguments

3. Applicant's arguments filed 02-17-2006 have been fully considered but they are not persuasive. Applicant argues that Gordon does not teach the presently recited microchannel structure or an entirely black disk. The argument is not persuasive because Gordon teach tracks of eletrophoretic gel for transporting samples, which gel would have constituted microchannel structures. Furthermore, the instant claims to not require the "entire" disk to be black. Applicant's reference to the specification as providing a special definition to the claim term "microchannel" is misplaced. Specifically, the only definitive characterization of a microchannel is found in paragraph [0076], which states that aliquots of fluid are transported and/or processed. Any further limits disclosed but not claimed are qualified by terms such as "typically" and "may." Similarly, Applicant's argument that limitations referenced in the specification, but not claimed, with respect to the detector head are not provided by the prior art are not persuasive. Unclaimed features and limitations may not be imported into the claims.

Applicant further argues that the prior art does not necessarily require laser induced fluorescence. The argument is not persuasive because the instant claims merely require that the detector head is capable of laser induced fluorescence.

Finally, applicant's arguments with respect to certain flow conditions for immobilization of substances are not persuasive because the instant claims are directed to a device, not to either a method of using or method of manufacture.

4. This is a Continued Examination of applicant's earlier Application No. 10/062258. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey R. Snay
Primary Examiner
Art Unit 1743

jrs

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